

Applicant: James H. Bennett
Serial No.: 10/052,973
Group Art Unit: 1774

REMARKS

Claims 34-44 and 46-53 remain in the Application with claims 34, 43, and 51 in independent format. Claim 45 has been cancelled and claims 34, 43, 46, and 51 have been amended. There is full support in the specification as originally filed for the amendments. Thus, no new matter has been introduced.

The Office Action Summary Form indicated that the current Action was non-final. However, the Examiner included form language in the conclusion of the Action indicating that this Action was final. Applicant verified with the Examiner in a teleconference that the Office Action Summary Form was correct and that the form language was incorrect. Therefore, Applicant's response conforms to a response for a non-final Action.

Claims 34-38, and 43-46 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,059,471 to McNally et al. The Examiner states that McNally teaches a tile product having a first layer of a thermoplastic extruded material and a second layer of a plurality of pigmented particles or chips.

Claim 34 has been amended to recite that the thermoplastic product consists essentially of an extruded thermoplastic layer or zone and a color-containing thermoplastic resin system. The color-containing thermoplastic resin system is disposed on and in direct contact with the surface of the extruded thermoplastic layer or zone such that the color-containing thermoplastic resin system bonds to the extruded thermoplastic layer or zone. Claim 34 is limited by the transitional phrase "consisting essentially of" to only those additions that do not materially affect the basic and novel characteristics of the claimed invention. The specification as originally submitted clearly indicates that one novel characteristic is the granite-like appearance of the product. The granite-like appearance results from the interaction between the extruded thermoplastic layer or zone and the color-containing thermoplastic resin system on the surface of the extruded thermoplastic layer or zone, absent additional adhesives (*see page 5, lines 2-7, and page 20, lines 18-22 of the originally submitted specification*). If additional adhesives are employed, as set forth in McNally, the product obtains a laminated finish about the

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particles that cover the entire surface to create a unique three dimensional appearance (*see McNally, col. 2, lines 20-24 and col. 4, lines 34-40*). The product formed by the two layers of adhesives in McNally no longer produces an appearance similar to that of natural granite.

Yet another novel characteristic is that the product has improved physical properties and characteristics, while still achieving the granite-like appearance. The physical properties are improved because the color-containing thermoplastic resin system is disposed on the surface of the extruded thermoplastic layer. Therefore, the color-containing thermoplastic resin system does not impair the physical strength of the extruded thermoplastic layer. The granite-like appearance is also achieved by having the color-containing thermoplastic resin system on the surface of and in direct contact with the extruded thermoplastic layer (*see page 2, lines 12-22 of the originally submitted specification*). The application of adhesives would prevent the color-containing thermoplastic resin system from being in direct contact with the extruded thermoplastic layer. This would prevent the color-containing thermoplastic resin system from bonding to the extruded thermoplastic layer and would effect the granite-like appearance of the product. McNally teaches forming the unique three dimensional appearance by shrinking UV coatings, i.e., adhesives, around the pigmented particles and chips. Therefore, the basic and novel characteristic of the claimed invention would not be obtained if adhesives were applied between the color-containing thermoplastic resin system and the extruded thermoplastic layer.

Claims 43 and 51 have also been amended to recite that the thermoplastic product comprises an extruded thermoplastic layer or zone and a color-containing thermoplastic resin system. The color-containing thermoplastic resin system comprises a thermoplastic resin and at least one of a colorant and a colorant mixture with the thermoplastic resin and the colorant or colorant mixture integrally formed as a plurality of particles. The plurality of particles are disposed on and in direct contact with the surface of the extruded thermoplastic layer or zone such that the thermoplastic resin of the resin system bonds to the extruded thermoplastic layer or zone. Referring to Figure 2 of the

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specification as originally submitted, the extruded thermoplastic layer is shown substantially free of the color-containing thermoplastic resin system. The plurality of particles is shown disposed on the surface of the extruded thermoplastic layer. The plurality of particles does not form a laminated, smooth surface as taught and suggested by the cited references. For a rejection under 35 U.S.C. §102(b), the reference must disclose each and every feature of the claimed invention.

McNally does not disclose a color-containing thermoplastic resin system that comprises a thermoplastic resin and at least one of a colorant and a colorant mixture with both integrally formed as a plurality of particles. Further, McNally does not disclose the plurality of particles disposed on and in direct contact with the surface of the extruded thermoplastic layer or zone such that the thermoplastic resin of the plurality of particles bonds to the extruded thermoplastic layer or zone.

Based upon the foregoing, it is believed that independent claims 34, 43, and 51, as amended, overcome the 35 U.S.C. §102 rejection and are allowable. Dependent claims 35-42, 44, 46-50, and 52-53, which depend directly or indirectly from the now allowable independent claims are also deemed allowable.

Claims 34-53 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 5,407,988 to Kogowski in view of McNally, United States Patent No. 6,136,441 to MacGregor et al., and United States Patent No. 5,496,630 to Hawrylko et al. The Examiner contends that Kogowski discloses granite-looking copolymers molded with colorants through an extruder and that McNally discloses a thermoplastic material comprising a colorant.

Applicant respectfully traverses the 35 U.S.C. §103(a) rejection, in view of the current amendments. When applying 35 U.S.C. §103, to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... *In re Vaeck*, 947

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F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §§2143-2143.03 for decisions pertinent these criteria.

To summarize the claims amendments, as discussed at length above, claim 34 claims the subject invention as a thermoplastic product consisting essentially of a color-containing thermoplastic resin system disposed on and in direct contact with the surface of an extruded thermoplastic layer or zone. Claims 43 and 51 claim the color-containing thermoplastic resin system comprising a thermoplastic resin and at least one of a colorant and a colorant mixture both integrally formed as a plurality of particles and disposed on and in direct contact with the surface of an extruded thermoplastic layer or zone. With reference again to Figure 2 of the specification as originally submitted, the plurality of particles is visible only on the surface of the extruded thermoplastic layer. Further, the plurality of particles does not form a smooth surface when disposed on the extruded thermoplastic layer.

The cited references, even if combined, do not teach or suggest a color-containing thermoplastic resin system comprising a thermoplastic resin and at least one colorant and colorant mixture both integrally formed of a plurality of particles. Further, the cited references do not teach or suggest the color-containing thermoplastic resin system being disposed on and in direct contact with the surface of the extruded thermoplastic layer or zone such that the thermoplastic resin system of the plurality of particles bonds to the extruded thermoplastic layer or zone without the use of additional adhesives. Thus, the prior art references, even when combined, do not satisfy the first criteria for establishing a prima facie case of obviousness. Therefore, it is believed that the claims as amended overcome the 35 U.S.C. §103 rejection and are deemed allowable.

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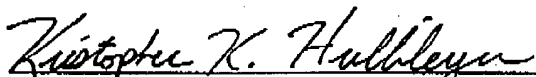
Accordingly, it is respectfully submitted that the Application, as amended, is now presented in condition for allowance, which allowance is respectfully solicited. Applicant believes that no fees are due, however, if any become required, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account 08-2789.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.

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Date


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